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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/530,096
Filing Date: April 1, 2005
Appellant(s): KUDO ET AL.

Michael S. Gzybowski
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 29, 2008 and response to notification of non-compliant appeal brief mailed July 29, 2008 appealing from the Office action mailed November 30, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct except there is a typographical error in line 3: "Whether claims 15-19 and 32" should have been read -- Whether claims 15-19, 32 and 34 --.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5 922 991	Bentz et al.	July 1999
JP 2000-154255	Fujita et al.	June 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 34 (line 3), it is not clear as to how tight/low the terms “tight” and “low” refer to.

Claims 15-19, 32 and 34 are rejected under 35 USC 103(a) as being unpatentable over Bentz (US 5 922 991) in view of JP255 (JP 2000-154255)(referred as Masayuki et al by Appellants).

For Claims 15-19 and 34, Bentz discloses an **automobile** wire harness sealed by a sealing material to avoid the damages resulting from **vibration**, etc. (col. 1, line 12 to col. 2, line 25 and Figures) Bentz is silent on the use of the specific material set forth in the present invention for the seal. However, JP255 teaches a sealing material

comprising A) an acrylic polymer containing at least one alkenyl group, B) a hydrosilyl group-containing compound and a hydrosilylation catalyst. ([0005], [0078], [0086] and Examples) Component A) can be derived from ethyl acrylate, n-butyl acrylate, 2-methoxyethyl acrylate and 1,7-octadiene. ([0008], [0032] and Examples) The molecular weight distribution of Component A) can be 1.8 or less. ([0010]) The molecular weight of Component A) is described in [0011]. The hardness of the cured composition is exemplified in [0094]. A filler can be used. ([0081]) Since JP255's material is substantially the same as that of Applicants', both should possess the same properties including compression set, loss tangent, tight adhesiveness to electrical wires, a low hardness, a low insertion resistance to electrical wires, etc. JP255's sealing material has **vibration absorption** capability for using in **automobiles**. ([0086]) The motivation of using the sealing material is to dampen the vibration. In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's sealing material for Benz's wire harness seal material with expected success.

For Claim 32, JP255 is silent on the amount of the filler. However, the filler amount will affect the physical properties of the cured material. In other words, the filler amount is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize a filler in whatever amount through routine experimentation in order to obtain a cured material having desired properties. Especially, Applicants do not show the criticality of the filler amount. See MPEP 2144.05 (II).

(10) Response to Argument

Rejection of claim 34 under 35 U.S.C. 112, second paragraph as indefinite

In view of Appellants' clarification, Examiner decided to withdraw the instant rejection.

Rejection of Claims 15-19, 32 and 34 under 35 U.S.C. 103(a) as being unpatentable over Bentz in view of JP255.

Argument 1: Appellants primarily argued that the contact elements in Bentz are not separate elements from Bentz's "entire arrangement", and further asserted that the vibration at the "entire arrangement" is directly transmitted to the contact elements so that vibration at the contact elements is not diminished by a vibration absorber, because there is no provision of a vibration absorber between the "entire arrangement" and the contact elements. (Appeal brief, page 5, last paragraph to page 8, 3rd paragraph from bottom) However, as a whole, Bentz does, as a whole, disclose an **automobile** wire **harness** sealed by a **sealing material** to avoid the damages resulting from **vibration**, etc. (col. 1, line 12 to col. 2, line 25 and Figures) More particularly, Bentz teaches a method of preventing contact breakage of a wiring harness due to **vibration** in automobile **engines** by utilizing an arrangement for mounting a wiring harness on a support plate where at least a portion of the wiring harness is **sealed** with a sealing medium. (col. 1, lines 11-16 and 44-52) As such, Bentz clearly recognizes the well-known **vibration problem**. Bentz further teaches the use of a sealing material to **seal** the harness in the arrangement. JP255 teaches a sealing

material having **vibration absorption** capability for using in automobile **engines**. ([0086]) The combination of the prior art components would have yielded the **PREDICTALBE RESULT** of lessening the adverse effect of vibration. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's **vibration absorbing** sealing material in Bentz's arrangement with expected success. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

Argument 2: Appellants primarily argued that Bentz's sealing material is in a liquid form, while the claimed one is a "solid". (Appeal brief, page 8, last paragraph to page 10, 1st paragraph) Examiner disagrees. First, a cured product is not necessarily a solid. It can be a liquid, a paste, a soft material, etc., depending on crosslinking density thereof. Second, although Bentz teaches that the sealing material is **usually processed** in fluid form in order to facilitate the **application** of the material (col. 2, lines 4-8) (emphases added), it does not mean that the final form of the sealing material stays as a liquid. Clearly, Bentz's sealant was processed in a liquid form and subsequently converted into a solid form as shown in Figures 1 and 2 where the material (70) **must** be solid in order to retain the contour depicted in these figures.

Argument 3: Appellants primarily argued that there is lack of motivation to combine Bentz and JP255 because Bentz' sealing materials can be polyurethanes, **silicone**, etc. that are known for use as corrosion-resistant sealing materials, while JP255 (i.e., Masayuki et al)'s composition can be used as vibration absorbing material for automobiles. (Appeal brief, page 10, 2nd paragraph to page 11, 1st paragraph)

Examiner disagrees. First, JP255's sealing material can be derived from a **silicone** as component (B). See English translation of JP255 ([0070]-[0075]). As such, **both** JP255 and Bentz indeed teach the employment of silicone-based materials as sealants.

Second, Bentz does, as a whole, disclose an **automobile** wire **harness** sealed by a **sealing material** to avoid the damages resulting from **vibration**, etc. (col. 1, line 12 to col. 2, line 25 and Figures) More particularly, Bentz teaches a method of preventing contact breakage of a wiring harness due to **vibration** in automobile **engines** by utilizing an arrangement for mounting a wiring harness on a support plate where at least a portion of the wiring harness is **sealed** with a sealing medium. (col. 1, lines 11-16 and 44-52) As such, Bentz clearly recognizes the well-known **vibration problem**. Bentz further teaches the use of a sealing material to **seal** the harness in the arrangement. JP255 teaches a sealing material having **vibration absorption** capability for using in automobile **engines**. ([0086]) The combination of the prior art components would have yielded the **PREDICTABLE RESULT** of lessening the adverse effect of vibration. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize JP255's **vibration absorbing** sealing material in Bentz's arrangement with expected success. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)

Argument 4: Appellants primarily argued that JP255's material is in a form of solid (e.g., gaskets, packing, etc.), and cannot be used as a sealant in Bentz's disclosure where the sealant is processed in a liquid form. (Appeal Brief, page 11, lines 5 to 15) Examiner disagrees. Bentz teaches that the sealing material is **usually**

processed in fluid form in order to facilitate the application of the material (col. 2, lines 4-8) It does not mean that it **must** be processed in a fluid form. Even if it were a necessity to process Bentz's sealing material in a fluid form, one of ordinary skill in the art would also know to utilize JP255's in a fluid form (i.e., uncured form) and form the sealing material *in situ* Bentz's arrangements, if needed because of certain specific configurations of the arrangements.

Argument 5: Appellants primarily argued that the claimed compositions provide certain properties/characteristics not taught or suggested by JP255. Examiner disagrees because the prior art's composition is substantially the same as the claimed one. Both should possess **similar properties/characteristics**. Furthermore, *prima facie* obviousness is **not rebutted** by merely recognizing additional advantages or latent properties present in the prior art. See MPEP 2145(II). Notably, Appellants have not yet affirmatively shown evidence of any alleged unexpected properties/characteristics.

(11) Related Proceeding(s) Appendix

None

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Kuo-Liang Peng/

Primary Examiner, Art Unit 1796

November 13, 2008

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